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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,032	03/25/2004	Michael C. Sefcik	25434-00077	5810
33772	7590	06/26/2006	EXAMINER	
MCDONALD HOPKINS CO., LPA 2100 BANK ONE CENTER 600 SUPERIOR AVENUE, E. CLEVELAND, OH 44114-2653			BONCK, RODNEY H	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/809,032	SEFCIK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rodney H. Bonck	3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

The following action is in response to the amendment and request for continued examination received June 7, 2006.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 11-15, 18, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 calls for "a sleeve having a shape substantially conforming to the predetermined shape of the clutch housing". It is impossible to determine from the claims how similar in shape the sleeve and housing would be to be for one to be considered "substantially conforming" to the shape of the other. Thus the intended metes and bounds of the claim cannot be determined. Method claim 11 suffers from the same deficiency to the extent that a structural limitation would be patentable weight in a method claim.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 3, 4, 7-10, 18 and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by Usoro('901). Usoro discloses a clutch comprising a clutch housing 12, a piston 28, and a sleeve 18 having a predetermined shape that conforms to the housing. The sleeve is positioned within the clutch housing and forms a fluid passageway 48,26 between the clutch housing 12 and the sleeve 18 and forms a piston reactive cavity between the clutch housing 12, the piston 28, and the sleeve 18. The sleeve, as seen in Fig. 1 of Usoro, has a portion that can be considered a first portion and two stepped portions readable as first and second stepped portions. The sleeve further includes a passage 50 which can be considered a fluid entry passage for the entry of fluid into balance chamber 46. Fluid travels through the entry passage and also travels through the fluid passageway and into the piston reactive cavity. The sleeve in Usoro has a surface for sealing engagement with the piston, as seen in Fig. 1. The Usoro device has a centrifugal compensation device 42, and the sleeve has a centrifugal retaining device 68 to retain the centrifugal compensation device. These claims call for "a driven mechanism connected with said clutch housing". This limitation is already met by the Usoro device since the spline on the inner surface of the housing can be considered "a driven mechanism" insofar as defined. Regarding claim 19, a "transmission" can be anything that transmits torque. The spline on the housing of Usoro is capable of mating with plates 22 of a clutch, which can be considered a transmission insofar as defined.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2, 11-17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Usoro('901). In Usoro, the housing 16 is shown mounted on sleeve 18. Since relative rotation is not permitted between the piston and the sleeve, it would have been obvious to one having ordinary skill in this art to mount the housing on the sleeve by an interference fit, the motivation being to firmly mount the housing for rotation with the sleeve. Regarding the method claims, it is submitted that the claimed steps of providing a housing, attaching a piston, providing a sleeve, positioning the sleeve,

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creating fluid passageways, and providing sealing surfaces would inherently be performed in making the device of Uoro. Claim 11 now further recites that the housing has a driven mechanism connected therewith. This is a structural limitation that would not carry weight in a claim to a method of assembly; but even giving weight to the new limitation, claim 11 does not distinguish over Uoro as explained above regarding claim 1.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uoro('901) in view of Leichter et al.('649). This claim calls for the use of "powered" metal for the sleeve. Leichter et al. disclose the use of powered metal as suitable for use in a coupling. It would have been obvious to use this material in the Uoro device, the motivation being to form sliding sealing surfaces, as taught by Leichter et al.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uoro('901) in view of Slesar et al.('193). These claims call the use of sintered iron for the sleeve. Uoro does not disclose a specific material for sleeve 18. Slesar et al. disclose the use of sintered iron for use in sleeves. It would have been obvious to use sintered iron for the sleeve 18 of Uoro, the motivation being to use a material taught as suitable for this environment.

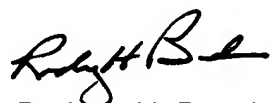
***Response to Arguments***

Applicants' arguments filed June 7, 2006 have been fully considered but they are not persuasive. Applicants argue that the sleeve 18 of Usoro does not substantially conform to the shape of the housing as called for in claim 1. It can be seen in applicants' Fig. 2, that the shape of sleeve 46 bears little resemblance to that of housing 34. Their shapes do conform, however, at 126 where they are connected. For that reason, the claim was initially considered to be accurate in the sense that a portion of the sleeve conformed to the shape of a portion of the housing. Thus the claim was merely considered broad rather than indefinite. It is apparent from applicants' remarks, however, that the claims are so open to varying interpretations that they do not meet the requirements of 35 USC 112, 2<sup>nd</sup> paragraph. It would be impossible to tell how similar in shape the sleeve and housing would need to be to infringe the claim. Thus the metes and bounds of the claim have not been adequately defined. For this reason, a rejection under 35 USC 112, 2<sup>nd</sup> paragraph, has been added. Giving the claims their broadest reasonable interpretation, they are still deemed properly rejected by the applied art for the reasons set forth in the rejections above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney H. Bonck whose telephone number is (571) 272-7089. The examiner can normally be reached on Monday-Friday 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (571) 272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Rodney H. Bonck  
Primary Examiner  
Art Unit 3681

rhb  
June 22, 2006